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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,577	01/12/2000	Glenn R. Toothman, III		5806

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EXAMINER

LEE, DIANE I

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/481,577

Applicant(s)

TOOTHMAN, LLL ET AL.

Examiner

D. I. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-9,12-16,24,28,31-33 and 55-65 is/are pending in the application.
- 4a) Of the above claim(s) 56-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-9,12-16,24,28,31-33 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 24 September 2004. Claims 1, 9, 24, 28, and 55 have been amended; claims 2-3, 10-11, 17-23, 25-27, 29-30, and 34-54 have been canceled; claims 56-65 have been newly added. Currently, claims 1, 4-9, 12-16, 24, 28, 31-33, and 55-65 are pending in the application.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 October 2004 has been entered.

Election/Restrictions

3. Newly submitted claims 56-65 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 56-65 are directed to the non-elected invention, which drawn to a system and method for providing information communicably connected to the remote database, such as an Internet or GPS receiver.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 56-65 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

4. Claim 24 is objected to because of the following informalities:

(a) Re claim 24, lines 1-5: The preamble phrase "A method for a historical notable location," should be rephrased to --A method for providing information related to a remote location, the information comprising memorial information about a deceased party and historical information about the remote location where the remote location comprises a cemetery location and a historical notable location,--. Such change would place the claim in better form.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 4-9, 12-16, 24, 28, and 31-33 are remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1: the phrase "wherein data corresponding to the memorial information is stored internally within the memory device, and wherein the memory device is free from physical connection to a source of the data, while the memory device is positioned at the cemetery location" is unclear to the examiner.

It is unclear at to what is the source of the data. Is applicant referring the power source as the source of the data? For examining purpose, the above phrase has been translated to mean that

-- wherein data corresponding to the memorial information is stored internally within the memory device, and wherein the memory device is free from physical connection to a power source, while the memory device is positioned at the cemetery location --

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Re claim 9: See the same discussion in claim 1 above.

Re claim 24: See the same discussion in claim 1 above.

Re claim 28: See the same discussion in claim 1 above.

Therefore, claims 1, 9, 24, 28, and claims depends therefrom (i.e., claims 4-8, 12-16, and 31-33) are vague and indefinite. Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 9, 12-13, 24, 28, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner [EP 380 727 A1, previously cited by the Examiner].**

Re claims 9, 24, and 28: Weiner discloses a system for providing information about a historically notable location (i.e., museum) or related to a geographically remote and publicly accessible location (i.e., exhibition environment), comprising:

a memory device 2, 92, 112 affixed to a physical object positioned at the historically notable location (i.e., museum) or the geographically remote and publicly accessible location (i.e., exhibition environment) and wherein the memory device storing information related to the article in the historically notable location (i.e., museum) or related to a geographically remote and publicly accessible location (i.e., exhibition environment) (see figures 1-14);

a portable memory reading device (a portable sound-producing unit 4), separate from the memory device, held by a user, that retrieves the stored information directly from the memory device via a non-permanent proximity link when positioned at the memory location (historically notable location such as a

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museum) and communicates the stored information to a user located at the historically notable location (i.e., museum) or the geographically remote and publicly accessible location (i.e., exhibition environment) via a speaker 10 and/or a display 34 (see figures 1-3 and 6-14);

wherein the memory device is a contactless device for data and power (i.e., the memory device includes a static memory unit therein and is a contactless device for storing the memorial information without power, i.e., the data corresponding to the historical information is stored internally within the memory device and wherein the contactless memory device is free from physical connection to a source of the data while the memory device is positioned at the historically notable location, see col. 10, lines 2+ and figures 8, 11) or a contact device (see figures 1-3, 6-7, and 9);

wherein said communication of the information stored in the memory to at least one of the public users located at the historically notable location (i.e., museum) or the geographically remote and publicly accessible location (i.e., exhibition environment) sequentially follows and is substantially temporally commensurate with said retrieval of the memorial information directly from the memory device (see col. 6, lines 54+ and col. 5, lines 1+); and

wherein the memory device comprises a programmable read only memory device (ROM) (see col. 12, lines 23+).

Weiner fails to teach the memory device comprises a programmable random access memory device (RAM).

However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize RAM device in the memory device in order to provide a rewriting capability so that information can be periodically updated if necessary.

Furthermore, applicant has admitted that claimed memory device is a known device at the time of the invention (i.e., applicant admitted on page 5 of the disclosure that in preferred embodiments of the invention, memory devices 2B-3B comprise a commercially available iButton® contact memory device,

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the mechanical and technical standards for which are incorporated hereby by reference. Memory devices 2B-3B may also comprise, in addition to contact memories, read only memory (ROM) devices, electronically erasable programmable read only memory (EEPROM) devices, electronically programmable read only memory (EPROM) devices, random access memory (RAM) devices, static random access memory (SRAM) devices, static bar codes, or any other device that is small in size, can be easily and permanently attached to a physical object, can store large quantities and varied types of information, and can withstand extreme weather conditions without losing or damaging the information stored therein and/or thereon. Also, applicant further admitted on page 12 of the applicant's response filed 9/24/04 that the support for the limitations "wherein the memory device comprises a contact memory device which utilizes programmable random access memory to store the memorial information, and wherein the portable memory reading device is capable of programming the memory device by writing the memorial information to the programmable random access memory" in claim 1 may be found at least on page 8, last paragraph (right column) of the iButton® standards document as incorporated by reference in the present disclosure on page 5, line 16 of the original specification and generally in the specification as filed. Thus, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a known memory device to the teaching of Weiner in order to provide a device that is small in size, which can be easily incorporated into the memory device for storing information further provide a rewriting capability so that stored information can be periodically updated if necessary.

Note: It is noted by the examiner that in claim 24, the limitation of the remote memorial and historical information related to a cemetery and a historical notable of the remote location is recited in the preamble, thus has not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process

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steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Re claim 12-13: wherein the memory device is permanently affixed to a stationary physical object (see figures 1, 12-14 for example).

Re claim 55: the contact memory device having a data connector (an input device or a plug 8, 43, 46, 83), wherein said data connector, upon wired connection to the said portable reader (see figure 1 for example) and upon contact with said memory device 4, 120 (i.e., upon plugged into said portable reader, see figures 1-3, 9), passed the information directly from said memory device positioned at the remote location to said portable reader located at the remote location via a non-permanent proximity link (see col. 6, lines 54+; col. 5, lines 1+; figures 1-3, and 9 for example).

9. **Claims 1, 4-8, 14-16, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner in view of Assisi [US 5,696,488, previously cited by the examiner].**

Re claims 1, 4-6, 14, and 31: Although Weiner teaches that the system is for providing information about a historically notable location (i.e., museum) or related to the geographically remote and publicly accessible location (i.e., exhibition environment); Weiner is silent with respect to the system for providing memorial information about a decease party entered at a cemetery location and the memory device is a weather resistant memory device.

Assisi discloses a system for providing memorial information about a decease party entered at a cemetery location (see the abstract). The system includes a computer 5 having a memory device 6 permanently affixed to a stationary physical object/location positioned at the cemetery location (i.e., the computer and the memory is directly located in the cemetery 1). The memory device is weather resistant memory device and memorial information stored in the memory device (see col. 1, lines 4+; col. 2, lines 7+; and the figure). The system further includes a portable memory reading device 3, 11 holdable by one

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of the visitor or public users, separate from the memory device of the cemetery location 1, that retrieves the memorial information directly from the memory device of the cemetery location when it is positioned at the cemetery location (i.e., wireless communication carried out when the portable memory reading device is brought into the vicinity of the memory device 2, which is a non-permanent proximity link).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the use of the system in other environment, for example, for providing a weather resistant information device at a cemetery location, as taught by Assisi, in the system of Weiner in order to expand the use of the information retrieval system in other environment.

Re claims 7-8, 15-16, and 32-33: Weiner teaches the stored information in the memory device is a audible recording sound message in different languages and a video signal (see col. 2, lines 14+); and

Assisi teaches the memorial information in the memory device of the cemetery location is in form of text, image or audio data in combination of the deceased person in the cemetery and may be call up by any visitor or public user with the portable memory-reading device 3, 11 (see col. 1, lines 35+ and col. 2, lines 23+).

Weiner as modified by Assisi fails to teach the specific language format of the information resides on the memory device such as extensible markup language or hypertext markup language formats.

However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize any suitable language format appropriate to the system. Furthermore, since applicant has not discloses that utilizing extensible markup language or hypertext markup language formats in the memory device would solve any stated problems or is for any particular purpose and it appears that the invention would perform equally well with any other applicable language/text format that is available. Therefore, it would have been an obvious design variation to a person skilled in the art. One might choose the specific text format in order to meet specific communication standards/requirements. Accordingly, it would have been an obvious expedient.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 9, 24, 28 have been considered but are moot in view of the new ground(s) of rejection (see the discussion above).

11. In response to applicant's statement on page 13, lines 6+ with respect to amending claim 1 to more distinctly point out and claim the present invention and to satisfies 35 U.S.C. § 112; the examiner points out that the amended claims does not satisfies the 35 U.S.C. § 112 (see the discussion above regarding 35 U.S.C. § 112).

12. In response to applicant's remark and request to cited U.S. Patent No. 6,008,727 issued to Want on PTO-892, the examiner cites U.S. Patent No. 6,008,727 has been cited on PTO-892 along with this Office Action.

13. In response to applicant's argument with respect to the invention of amended claim, specifically, "the memory device is free from physical connection to a source of the data, while the memory device is posited at the cemetery" is neither shown nor suggested by the cited prior art. Applicant also argued that Weiner is completely silent as to the source of the data that is eventually provided in circuitry 20 in memory unit 2 (Weiner's Figure 2) and further argued that Weiner does not teach providing any source of the data within circuitry 20 whatsoever (see page 13, lines 3+ of Applicant's response). The examiner respectfully disagrees. First of all, applicant has not clearly defined the source of the data in the claim. The examiner has translated that "the source of the data" to be --a power source of the data--. Weiner's Figure 2 clearly shows that the circuitry 22 for receiving electrical energy from the portable memory reading device (the sound producing unit 4 having a power supply 25) to the memory unit from via one path 23. Accordingly, the applicant's argument on this point is not persuasive.

With respect to the limitation "wherein the memory device comprises a contact memory device which utilizes programmable random access memory to store the memorial information, and wherein the

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portable memory reading device is capable of programming the memory device by writing the memorial information to the programmable random access memory", the examiner has taken the position that such device is a known device, since applicant has admitted that claimed memory device is a known device at the time of the invention (i.e., applicant admitted on page 12 of the applicant's response filed 9/24/04 that the support for the limitations "wherein the memory device comprises a contact memory device which utilizes programmable random access memory to store the memorial information, and wherein the portable memory reading device is capable of programming the memory device by writing the memorial information to the programmable random access memory" in claim 1 may be found at least on page 8, last paragraph (right column) of the iButton® standards document as incorporated by reference in the present disclosure on page 5, line 16 of the original specification and generally in the specification as filed.)

Thus, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a known memory device to the teaching of Weiner in order to provide a device that is small in size, which can be easily incorporated into the memory device for storing information further provide a rewriting capability so that stored information can be periodically updated if necessary (see the discussion above).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Anders et al. [US 4,656,463] discloses a memory device, i.e., tag, with a variety of memory media (i.e., ROM, RAM, PROM, EPROM, EEPROM, and etc.)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. I. Lee
Primary Examiner
Art Unit 2876

D. L.